

### **REMARKS**

Applicants would like to thank the Examiner for taking the time to meet and to discuss the claims and the cited references. Claims 104-112 and 121-126 are pending in the application. This Amendment is in response to the Office action dated September 11, 2007 and accompanies a petition for a three month's extension of time to March 11, 2008. The Office action rejected claims 104, 108, 110, 112, 122, and 124 under 35 U.S.C. §112 second paragraph. Claims 111 and 121 appear to have similar objections. Claims 104-112 and 121-126 are rejected as being unpatentable under 35 U.S.C. §103(a) over Fredlund et al. ("Fredlund") (U.S. Patent No. 5,666,215) in view of Morris et al. ("Morris") (U.S. Patent No. 5,153,936). The applicants note for the convenience of the examiner that a Terminal Disclaimer was previously submitted in this application on December 5, 2002. The applicants respond as follows.

### **SECTION 112 REJECTIONS**

It is alleged on page 2 of the Office action that claim 104 uses the term "allowing," and that this term is not a positive recitation and is allegedly thus indefinite. The applicants respectfully submit that the "means for *allowing* the authorized user to download the low resolution copy of the high resolution digital image of the first image provider from the electronic storage facility to a first location" recited in claim 104 clearly describes a specific feature of the digital image management system and that the recitation is indeed a positive limitation. Furthermore, applicants note that the Patent Office has issued 1,135 U.S. patents just within the months of January and February of 2008 with the term "allowing" in one or more of the issued claims. The applicants thus believe that claim 104 fully meets the requirements of 35 U.S.C. §112 second paragraph and that the rejection should be withdrawn.

It is also alleged on page 2 of the Office action that claim 121 uses the term "allowing." The applicants respectfully submit that the "means for *allowing* the authorized user to identify a high resolution digital image" recited in claim 121 clearly describes a specific feature of the digital image management system and that the recitation is indeed a positive limitation. Thus, claim 121 fully meets the requirements of 35 U.S.C. §112 second paragraph and that the rejection should be withdrawn.

Page 2 of the Office action alleges that claim 111 uses the term “permitting,” and that similar to the term “allowing,” the term “permitting” is not a positive recitation and is allegedly thus indefinite. The applicants respectfully submit that the step of “permitting the first image provider to locate and download the low resolution copy of the digital image provided by the first image provider, the second digital image provided by the second image provider being transparent to the first image provider” recited in claim 111 clearly describes a specific action that the method enables the first image provider to perform, and that the recitation is a positive limitation. Furthermore, applicants note that the Patent Office has issued 345 U.S. patents just within the months of January and February of 2008 with the term “permitting” in one or more of the issued claims. The applicants thus believe that claim 111 fully meets the requirements of 35 U.S.C. §112 second paragraph and that the rejection should be withdrawn.

It is alleged on Page 3 of the Office action that claims 108, 110, 112, 122, and 124 use the term “adapted to,” and that the term “adapted to” is a type of language that suggests or makes optional but does not require steps to be performed, and thus does not limit the claim scope. Section 2111.04 of the MPEP cited in the Office action states that the term “adapted to” “may raise a question as to the limiting effect of the language in a claim,”...and that “[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.” In each of claim 108, 112, 122, and 124, the term “adapted to” precedes language in a recitation that further describes a specific structural component, namely, a searching engine. The language following the term “adapted to” in these claims thus limits the claims by way of further defining the searching engine. Similarly, the language following the term “adapted to” in claim 110 provides further description of an image handler, thus further limiting the claim. It is also respectfully noted that the Patent Office has issued 2,377 U.S. patents just within the months of January and February of 2008 with the term “adapted to” in one or more of the issued claims. The applicants thus believe that claims 108, 110, 112, 122, and 124 fully meet the requirements of 35 U.S.C. §112 second paragraph and that the rejections should be withdrawn.

### **SECTION 103 REJECTIONS**

The 35 U.S.C. §103 rejections are overcome because of the reasons stated in previous amendments, and in particular, in the amendment submitted June 28, 2006, pages 13-19, as

well as the Rule 132 Declaration of Carl E. Moore, Jr. Applicants do not repeat those reasons here other than to incorporate them by reference. Moreover, as the Examiner acknowledged in the recent interview, the Examiner is now in agreement that each of the pending claims is indeed nonobvious in view of the cited references. In view of the foregoing, all of the claims are allowable over the cited references, and passage to allowance is respectfully requested.

The Examiner is respectfully requested to pass this application to issue. If the Examiner wishes to discuss any aspect of this response or the case in general, she is urged to contact the applicants' undersigned attorney. Should any additional fees be required, the Commissioner is authorized to charge or debit Deposit Account No. 13-2855.

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Respectfully submitted,

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